

### **REMARKS/ARGUMENTS**

Claims 1-32 are pending in the application and currently stand rejected by the Examiner. By way of the present amendment, claims 8 and 30 have been amended, no claims have been cancelled, and no new claims have been added. Applicants request entry of this amendment given the amendments and remarks made herein.

### **Drawings**

The Examiner has objected to the Drawings under 37 CFR 1.83(a). [Office Action, pages 2-3] More specifically, the examiner asserts that:

i), the elements in Fig. 3 should be labeled with indicia indicative of their function; and

ii) the following objects are not shown in the drawings:

- a) the “known object,”
- b) the “imaging mark on the calibration surface,”
- c) the “calibration surface,”
- d) the “photosensitive material,”
- e) the “silkscreen material,”
- f) the “Zapit paper,”
- g) the “luminescent material,”
- h) the “image capture device,”
- i) the “microscope camera,”
- j) the “chrome layer on a glass plate,”

Applicants respectfully traverse such objections as follows.

Regarding i), the elements in Fig. 3 allegedly lacking labeling “with indicia indicative of their function,” Applicants generally traverse this objection as failing to provide any basis under the patent laws or rules for asserting that additional labeling (beyond the reference numerals already shown on each of the illustrated structures) is required. More specifically, the elements of Fig. 3 are each already labeled, including with reference numerals 14, 102, 104, 106,

. . . and 140, as described in paragraphs 38 and 39 of the originally filed specification as published as Patent Application Publication US 2005/0215986 (hereinafter “the originally filed specification”). Hence, applicants request that this objection be removed, or that the basis for the objection under the MPEP, the Code of Federal Regulations, and/or the applicable statutes be provided.

Regarding *ii*) a), the “known object” is shown in the drawings in at least Fig. 2 by the structure identified by reference numeral 30, which is identified as “known object 30” in the first line of paragraph 37 of the originally filed specification.

Regarding *ii*) b), the “imaging mark on the calibration surface,” is shown at least as elements 28 and 40 of Figs. 1 and 4A, respectively. Regarding *ii*) c) the “calibration surface” is shown at least as element 18 in Fig. 1. Regarding *ii*) g) the “chrome layer on a glass plate” is shown as at least element 36 of Fig. 2. These structures are referenced in the originally filed specification with substantially corresponding language in at least paragraph 40, which states: “the known object 30 and calibration surface 18 . . . may be positioned in at least one of a laser focus plane or a treatment plane. The imaging of the chrome dot 36 and imaging of the mark 28 on the calibration surface 18 are performed along the imaging optical path . . . .”

Regarding *ii*) d)-g), per paragraph 14 of the originally filed specification, the calibration surface may comprise a variety of materials, including the “photosensitive material,” the “silkscreen material,” the “Zapit paper,” and the “luminescent material.” Hence, each of these exemplary embodiments of calibration surface materials is also shown in the drawings by at least calibration surface 18 of Fig. 1. Additionally, Applicants have deleted the “Zapit paper” from the claims, so that item *ii*) f) is also now moot.

Regarding *ii*) h) the “image capture device,” and *ii*) i) the “microscope camera,” per paragraph 34 of the originally filed specification, “The image capture device 20, preferably a microscope camera, is oriented toward an eye treatment plane.” Hence, these structures are both shown in the drawings by at least reference numeral 20 of Fig. 1.

As the reference numerals of Fig. 3 are properly identified in the specification so as to comply with the drawing rules, and as each and every one of the elements identified in the

Office Action was shown in the drawings, applicants respectfully submit that the objections to the drawings are improper. Applicants therefore request that the objections be removed.

For the record, Applicants also respectfully note that reference numerals for elements included in the independent claims were provided to the Examiner prior to the imposition of these rejections on at least pages 3 and 4 of the Appeal Brief filed by Applicants for this case on October 29, 2008.

### **Objections to the Claims**

Claims 8 and 30 were objected to under 35 USC 112, second paragraph, due to the use of a trademark/trade name as a limitation in said claims. [Office Action pages 3-4] Applicants have amended these claims so as to delete the specific term "Zap-it paper." Applicants note that the broader claim from which these claims depend remain unchanged and that the more general term "photosensitive material" remains in the claims themselves (so that applicants are not effectively reducing claim scope by the present amendment). Nonetheless, as the amendment complies with the examiner's requirements of form and simplifies the issues remaining in the application in preparation for appeal, applicants request that the amendment be entered and that the objections to the claims be removed.

### **Claim Rejections - 35 USC §103**

Claims 1-14, 16-24, and 26-32 are rejected under 35 USC §103(a) as allegedly unpatentable over Kern in combination with Hofer and L'Esperance, Jr. [Office Action pages 4-5] Claim 15 is rejected under 35 USC §103(a) as allegedly unpatentable over Kern in combination with Hofer and L'Esperance, Jr., as applied to claims 1-14, 16-24, and 26-32, and further in view of Noh. [Office Action page 5] Claim 25 is rejected under 35 USC §103(a) as allegedly unpatentable over Kern in combination with Hofer and L'Esperance, Jr., as applied to claims 1-14, 16-24, and 26-32, and further in view of Telfair.

Applicants have sought an in-person interview with the Examiner and with the Examiner's supervisor, S.P.E. Henry Johnson, to address these issues, as well as to address the objections to the drawings described above. Applicants' request for such an interview was

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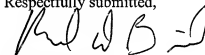
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denied. Hence, as suggested on page 2 of the Office Action, applicants have initiated a new appeal by filing of a Notice of Appeal on December 18, 2009. Applicants will address these rejections under the Appeal to the Board.

**CONCLUSION**

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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